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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,403	01/24/2002	Thomas Lee McLaughlin	26651US10	3309

116 7590 01/23/2004

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EXAMINER
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LAZOR, MICHELLE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/056,403

Applicant(s)

MCLAUGHLIN ET AL.

Examiner

Michelle A Lazor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 and 19-22 is/are allowed.
- 6) ☒ Claim(s) 4,5,12-18 is/are rejected.
- 7) ☒ Claim(s) 16 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 4 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Sanders (U.S. Patent No. 5344693).

Regarding Claims 4 and 5, Sanders discloses a method of manufacturing pressure-sensitive tape comprising the steps of feeding a substrate, inherently, along a manufacturing line, combining a layer of pressure-sensitive adhesive with a first face of said substrate, printing said layer of pressure-sensitive adhesive with a patterned adhesive-inhibiting masking to define a masking pattern comprising at least one continuous line, slitting through said substrate, adhesive layer, and masking along (*i.e. running parallel to*) said at least one continuous line defined by

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said pattern coating to form a slit tape having an edge thickness substantially equal to the average thickness of the tape across its width (Figure 1; column 2, lines 48 – 55 and column 3, line 56 – column 4, line 2), and further processing said slit tape by releasably combining the side of said pressure-sensitive adhesive layer bearing said masking against a second substrate face, said second substrate face comprising the other face of said first-named substrate to thereby produce a self-wound tape, or comprising the face of an additional substrate to thereby produce a multisubstrate tape, in which said combining of said pressure-sensitive layer against said second substrate face is preceded by the coating of at least parts of said second substrate face with a release coating (column 4, lines 5 – 14). Thus Sanders discloses all the limitations of Claims 4 and 5, and anticipates the claimed invention.

3. Claims 12 – 14 and 16 – 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Meetze (U.S. Patent No. 5980676).

Regarding Claim 12, Meetze discloses a method of making roll stock providing a substrate having a length extending in the machine direction, a width extending in the machine cross direction, and a substrate surface, combining said substrate with a pressure sensitive adhesive layer, said pressure sensitive adhesive layer having a length extending in the machine direction, a width extending in the machine cross direction substantially equal to the width of said substrate, and an exposed adhesive surface remote of said substrate surface, applying adhesive inhibiting masking to said exposed adhesive surface of said pressure-sensitive adhesive layer along a continuous machine direction line or zone extending across a portion of said width of said exposed adhesive surface to form a non-adhesive line or zone and adjacent adhesive surface line or zone substantially free of masking, said roll stock having a substantially uniform

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thickness from edge to edge with said masking having a thickness in the order of microns, and winding said substrate and pattern coated adhesive layer into a roll (Figure 2; column 10, lines 40 – 53 and column 11, line 52 – column 12, line 13). Although Meetze discloses a preferred embodiment which includes adhesive area (12a) which does not run all the way out to the edge of the tape, Meetze does not exclude embodiments wherein the adhesive does run all the way to the edge of the tape (column 12, lines 1 – 5). Thus Meetze discloses all the limitations of Claim 12, and anticipates the claimed invention.

Regarding Claims 13 and 14, Meetze discloses said adhesive-inhibiting masking is applied at a plurality of spaced locations along the width of said exposed adhesive surface, wherein said substrate also includes side edges extending in the machine direction, and said roll stock has an edge thickness substantially equal to the average thickness of the roll stock across its width (column 11, lines 1 – 15 and column 11, line 52 – column 12, line 13). Thus Meetze discloses all the limitations of Claims 13 and 14, and anticipates the claimed invention.

Regarding Claim 18, Meetze discloses applying additional adhesive-inhibiting masking to said exposed adhesive surface of said pressure-sensitive adhesive layer along a second continuous machine-direction line or zone extending across another portion of said width of said exposed adhesive surface to form a second nonadhesive line or zone (column 11, line 52 – column 12, line 13). Thus Meetze discloses all the limitations of Claim 18, and anticipates the claimed invention.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meetze.

Meetze discloses applying said adhesive inhibiting masking at the side edge of a substrate (Figure 2; column 10, lines 40 – 53), but does not specifically speak to masking each side edge.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to mask each side edge to allow for flexibility of the tape to be removed from either edge.

#### *Allowable Subject Matter*

6. Claims 1 – 3 and 19 – 22 are allowed for reasons stated in the Office Action mailed 9/11/03. In addition, there was no reference in the prior art that disclosed, taught or suggested *slitting said substrate, adhesive layer, and masking* along said line or lines. Meetze discloses slitting said substrate and adhesive layer after the adhesive-inhibiting masking has been coated on the substrate, however, Meetze does not disclose or suggest cutting said substrate, adhesive layer, *and* the masking.

7. Claims 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. There was no reference in the prior art that disclosed, taught or suggested *slitting said substrate, adhesive layer, and masking* along said line or lines, as discussed above.

#### *Response to Arguments*

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Regarding the rejection of Claims 3 and 5 under 35 USC 112, in view of the amendment, the rejection is withdrawn.

Regarding the rejection of Claims 4 and 5 by Sanders, Examiner maintains the rejection. It is of the opinion of the Office that at least one continuous line includes embodiments including dashed lines as disclosed by Sanders. There is no language in the claim which more narrowly defines the at least one continuous line, as a line which is unbroken. However, the claim would be considered allowable if the claim were amended to include the limitation, "at least one continuous unbroken line". In addition, the method disclosed by Sanders is capable of slitting through the substrate and adhesive layer, as well as the adhesive-inhibiting layer, as claimed.

Regarding the arguments made for Claims 12 – 14 concerning the rejection by Sanders, Examiner agrees and withdraws these rejections.

Regarding the rejection of Claim 12 by Meetze, Examiner maintains the rejection. As stated above, although the preferred embodiment includes adhesive area (12a) which does not run all the way out to the edge of the tape, Meetze does not exclude embodiments wherein the adhesive does run all the way to the edge of the tape (column 12, lines 1 – 5), especially when considering Meetze discloses "killing" the adhesive in selected strips" (column 11, line 52 – column 12, line 13).

Further, regarding Meetze, Meetze discloses providing a uniform thickness roll stock through the use of a roller spreading the silica mixture onto the adhesive in selected areas. Therefore the thickness of the roll stock would be considered to be substantially uniform. Also, it is considered obvious to modify the method disclosed by Meetze to coat a continuous line or zone of masking at each of the side edges of the substrate, as discussed above.

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*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle A Lazor whose telephone number is 571-272-1232.

The examiner can normally be reached on Mon - Wed 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



MAL  
1/13/04



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